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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/730,326   | 12/08/2003  | Mitsuhiro Yamazaki   | JP920020177US1      | 2433             |
| 53493  | 7590        | 06/12/2007           | EXAMINER            |                  |
| LENOVO (US) IP Law<br>1009 Think Place<br>Building One, 4th Floor 4B6<br>Morrisville, NC 27560 |             |                      | DU, THUAN N         |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2116   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 06/12/2007   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 10/730,326             | YAMAZAKI ET AL.     |  |
| Examiner                     | Art Unit               |                     |  |
| Thuan N. Du                  | 2116                   |                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 December 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) 8,9,14 and 15 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-7,10-13 and 16-19 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/11/06.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 20070604.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-19 are presented for examination.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, 10-13 and 16-19, drawn to turning off a specific function when not used, classified in class 713, subclass 320.
  - II. Claims 8, 9, 14 and 15, drawn to power source monitoring, classified in class 713, subclass 340.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as monitoring the power supply upon waking up the device. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the

present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Joscelyn G. Cockburn on May 30, 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7, 10-13 and 16-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8, 9, 14 and 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 use the phrase “capable of” which constitutes a use limitation and thus renders the claims indefinite as to what structure is embraced by the metes and bounds of the claim language. See MPEP § 2111.04.

Claims 2-7 are also rejected for incorporating the above deficiency by dependency.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 10-13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breen et al. [Breen], U.S. Patent No. 6,928,568 in view of Saeki et al. [Saeki], U.S. Patent No. 6,657,415.

10. As per claim 1, Breen teaches a computer comprising:  
a system (205) [Fig. 2];  
an AC power supply operatively connected to said system for supplying said system with power [col. 3, lines 48-52];  
a battery (250) operatively connected to said system and which is charged with power from said AC power supply and then discharged to supply power to said system [col. 3, lines 55-60];

a circuit (214) operatively connected to said battery and said AC power supply [col. 4, lines 27-30] for charging the battery when said system being powered on or off [col. 1, lines 39-51].

Breen does not explicitly teach that a charging function to said battery is turning off while said battery is connected to said AC power supply.

Saeki teaches a computer comprising:

a system;

an AC power supply operatively connected to said system for supplying said system with power [col. 5, lines 18-22];

a battery (10) operatively connected to said system and which is charged with power from said AC power supply [Fig. 2; col. 5, lines 24-27] and then discharged to supply power to said system [col. 8, lines 27-31];

a circuit (12) operatively connected to said battery and said AC power supply [Fig. 2] which is capable of turning off a charging function to said battery while said battery is connected to said AC power supply with said system [col. 6, lines 19-22].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Breen and Saeki because they both teach system for charging a battery with AC power. Saeki's teachings of turning off the charging function would not only reduce the power consumption of the system but also increase the reliability of the system by preventing the battery overcharged.

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11. As per claim 2, Breen teaches that the system is powered off during charging said battery [col. 1, lines 45-48]. Saeki teaches that the charging function to the battery is turned off after the charging is completed [col. 6, lines 19-22].

12. As per claim 3, Saeki teaches that said circuit can turn on charging function to said battery if said AC power supply has shifted from not being connected to being connected with said system powered off [col. 8, lines 27-51].

13. As per claim 4, one of ordinary skill in the art would have recognized that the battery taught by Breen or Saeki is replaceable. Therefore, the new battery, if not fully charged, is obviously charged upon installation.

14. As per claim 5, Saeki teaches that said circuit turns on charging function to a battery after a predetermined time period (the time when the battery voltage has dropped below a threshold) has passed with charging function to the battery turned off [col. 8, line 65 to col. 9, line 7].

15. As per claim 6, both Breen and Saeki teach a regulator (AC adapter) operatively connected to said circuit (charging circuit) for supplying a small amount of power to said circuit [Fig. 2].

16. As per claims 10-13 and 16-19, they do not teach or further define over the limitations recited in the rejected claims above. Therefore, claims 10-13 and 16-19 are also rejected as being unpatentable over Breen in view of Saeki for the same reasons set forth in the rejected claims above.

***Allowable Subject Matter***

17. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan N. Du whose telephone number is (571) 272-3673. The examiner can normally be reached on Monday-Friday: 7:30 AM - 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached at (571) 272-3676.

Central TC telephone number is (571) 272-2100.

The fax number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

TD  
June 4, 2007



THUAN N. DU  
PRIMARY EXAMINER